

R E M A R K S

Claims 1 to 76 are pending

Claims 1, 12, 21, 33, 34, 35, 37, 38, 43, 45, 47, 48, 49, 51, 56, 58, 60, 61, 62, 64, 69, 71, 73, 74, and 75 are independent

A. Section 101 Rejections

Claims 1 to 32 and 51 to 63 stand rejected under 35 U.S.C. Section 101 “because these claims have no connection to the technological arts (i.e. computer, network, data processing, internet, etc.).” In addition, Claims 1 to 76 stand rejected under 35 U.S.C. Section 101 “because the claimed processes do not achieve a practical application.” Applicants respectfully traverse these Section 101 rejections. Neither of the Examiners’ bases of rejection are proper grounds for rejecting a claim under Section 101 and Applicants respectfully request that the Examiner provide support for his rejections.

The Federal Circuit has made it clear that the only issue in determining the presence of statutory subject matter is whether the claimed invention produces a useful, concrete, and tangible result. *See AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). That inquiry has not been applied in this rejection, despite the conclusory language on page 2.

In fact, all of the pending claims do produce a useful, concrete and tangible result. For example, Claim 1 recites “determining to accept an offer,” which is clearly a very useful, concrete and tangible result in, for example, a process of forming a contract. Likewise, Claim 12 recited “determining an offer,” which also is clearly a very useful, concrete and tangible result in forming a contract. Thus, Applicants respectfully request withdrawal of the Section 101 rejections.

B. Section 112 Rejection

Claims 1 to 32 and 51 to 63 also stand rejected under 35 U.S.C. Section 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” The Examiner asserts that the independent claims are indefinite because “[i]t is not clear who is receiving information, who is sending information, and who is determining to accept an offer.” As indicated in the claims, any entity may receive or send information and accept an offer. Numerous examples are provided throughout the specification. See for example, page 8 and 9 of Applicants’ specification. Applicants request an explanation as to what basis the Examiner has to require Applicants to restrict their invention to steps in which a particular entity performs the method steps. More specifically, for example, in Claim 1, it is clear that the recipient of the information is the same entity that determines whether to accept an offer based on the information. (There is no sending information recited in

Claim 1.) For example, the specification makes it very clear that in some embodiments, a controller 200, may receive information and accept an offer. Clarification is respectfully requested as to what is indefinite. Thus, absent a showing that a term is unclear or something about the claim is indefinite, Applicants respectfully request withdrawal of the Section 112 rejection.

C. Section 103 Rejection

Claims 1 to 76 also stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Garfinkle (US 6,512,570) in view of Official Notice. Applicants respectfully traverse the Section 103 rejection. Garfinkle is directed to a method of processing digital images and distributing visual prints produced from the digital images. Despite the Examiner's assertions to the contrary, the reference is devoid of any teachings related to redeeming products and determining whether to accept offers based on information regarding the redemption. The Examiner asserts that because Garfinkle discloses generically transferring information over the Internet, Applicants' specific type of information transfers would be obvious. The Examiner is essentially claiming that all species of a genus are obvious because the reference discloses an example of the genus. It is well settled that such a rejection is improper. *See In re Jones*, 958 F.2d 347, 350, 21 USPQ 2d 1941, 1943 (Fed. Cir. 1992) (rejecting Commissioner's argument that "regardless [] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it"). Thus, Applicants respectfully request withdrawal of the Section 103 rejection.

Further, the officially-noted subject matter improperly comprises principal evidence upon which the rejection was based. From the Official Notice described in the Office Action, Applicants cannot properly determine what "types of information" have been transferred over the Internet. Accordingly, Applicants cannot precisely describe how the present invention would distinguish over this material since the exact nature of the material is unstated. However, Applicants dispute that any prior art information transfers were used at all in connection with redeeming products and determining whether to accept offers based on information regarding the redemption as recited in Applicants' claims. Accordingly, Applicants request a reference to describe the official noted subject matter in more detail. MPEP 2144.03.

Further, there are numerous instances where the officially-noted subject matter comprises principal evidence upon which the rejection was based. Applicants dispute all of the various assertions in the Office Action regarding what is "old and well known." Applicants likewise dispute all assertions which were not proper factual findings because they are mere unsupported conclusions.

Officially-noted subject matter cannot be used as the primary basis for a rejection under 103. In other words, official notice alone of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art.

See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the

Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added);

In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**") (emphasis added);

In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

Official Notice may be used, if at all, to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching.**") (emphasis added).

Thus, absent support for the factual assertions made by the Examiner (that are not properly in the record), Applicants respectfully request withdrawal of the Section 103 rejection for this additional reason.

Further, the Examiner has not met his burden of establishing a *prima facie* case of obviousness in that he has not provided a proper motivation to combine the Garfinkle reference and the officially-noted subject matter. The Examiner does not identify anything in the references that suggests making his combination and merely provides his own conclusory assertions as to why one would have been motivated to make his combination. For example, the Examiner asserts that "[i]t would have been obvious to a person of ordinary skill in the art to include Garfinkle receiving the specific information limitations as detailed in the instant claims, because information is critical to making sound decisions and assuring transactions are fulfilled properly, timely and optimally." No reasoning, much less convincing reasoning, is provided. Thus, for this additional reason, Applicants respectfully request withdrawal of the Section 103 rejection.

Further, the Examiner's entire Section 103 rejection of Applicants' 76 claims (including 25 independent claims) is contained in only three paragraphs spanning little more than one page. It is clear that the Examiner has not identified many of the features, recited in Applicants claims, in any reference. Thus, for this additional reason, Applicants respectfully request withdrawal of the Section 103 rejection.

D. Conclusion

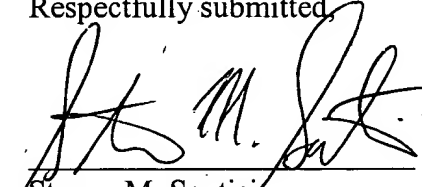
Applicants believe that all of the pending claims are in condition for allowance. The Examiner's early re-examination and consideration are respectfully requested. If there remains any question regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Steven Santisi at telephone number (203)461-7054 or via electronic mail at ssantisi@walkerdigital.com.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

December 24, 2003

Date

Respectfully submitted,



Steven M. Santisi
Attorney for Applicants
PTO Reg. No. 40,157
Walker Digital, LLC
(203) 461-7054 /phone
(203) 461-7300 /fax